

## Remarks

Claims 1-5 and 7-9 were pending in the above-identified application when last examined. Claims 1-5 and 7-9 are presented for reconsideration and allowance.

### Claim Rejection under 35 U.S.C. § 102

Examiner rejected claims 1-2, 4, and 7-9 as being anticipated by Gilliland et al. (US 6,416,238). Applicants respectfully traverse this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

The Examiner states:

In Figure 1, Gilliland discloses an optical assembly comprising a package (10) including an optoelectronic component; an alignment feature (20) mounted to a surface of the package; and a sleeve (30) defining only one bore (32) with an inner surface having a constant inner diameter for receiving and contacting outer surfaces of the alignment feature (20) and a ferrule of a fiber optic connector when the alignment feature and the ferrule are inserted into the bore at opposite ends of the bore so they can be aligned relative to each other.

(See Office Action, page 2)

In the present case, not every feature of claims 1 and 2 are represented in the *Gilliland* reference. Applicants respectfully submit that *Gilliland* does not disclose an alignment feature mounted to a surface of the package and a sleeve receiving the alignment feature and a ferule of a fiber optic connector. Can 30 includes an aperture 32 for receiving a transparent 20. (See *Gilliland*, Col. 4, lines 60-66). Transparent element 20 provides a window in the otherwise opaque can 30 so that an optical diode 80 mounted on the substrate can emit light from the package 10. Transparent element 20 and can 30 are part of package 10 and they cannot be an alignment feature mounted to package 10 and a sleeve receiving the alignment feature.

Due to the shortcomings of the *Gilliland* reference described in the foregoing, Applicants respectfully assert that *Gilliland* does not anticipate Applicant's claims 1 and 2. Therefore, Applicants respectfully request that the rejection of claims 1 and 2 be withdrawn.

Dependent claims 4, 8, and 9 further define patentably distinct independent claim 1. Therefore, dependent claims 4, 8, and 9 are also believed to be allowable. For at least the above reason, Applicants request reconsideration and withdrawal of the rejection of Claims 4, 8, and 9 under 35 U.S.C. § 102.

Dependent claim 7 further defines patentably distinct independent claim 2. Therefore, dependent claim 7 is also believed to be allowable. For at least the above reason, Applicants request reconsideration and withdrawal of the rejection of under 35 U.S.C. § 102.

### **Claim Rejection under 35 U.S.C. § 103**

Examiner rejected claim 3 under 35 U.S.C. 103(a) as being unpatentable over Gilliland in view of Yonemura et al. (US 6,540,412 B2). Applicants respectfully traverses this rejection.

Regarding claim 3 the Examiner states the following:

It would have been obvious to the one having ordinary skill in the art to recognize the alignment feature (20) taught by Gilliland would be modifiable with a similar size having a bore that would allow a light emitted by the package to pass through.

(Pages 3 & 4, Office Action)

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). In addressing obviousness determinations under 35 U.S.C. § 103, the Supreme Court in *KSR International Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007), reaffirmed many of its precedents relating to obviousness including its holding in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). In *Graham*, the Court set out an objective analysis for applying the statutory language of §103:

Under §103, the scope and content of the prior art are to be determined, differences between the prior art and the claims at issue are to be ascertained, and the level of ordinary skill in the pertinent art are to be resolved. Against this background the obviousness or non-obviousness of the subject matter is to be determined. Such secondary considerations as commercial success, long-felt but unresolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *KSR, slip op.* at 2 (citing *Graham*, 383 U.S. at 17-18).

In *KSR*, the Court also reaffirmed that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* at 14. In this regard, the *KSR* court stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does … because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* at 14-15. Traditionally, to establish a *prima facie* case of obviousness, the CCPA and the Federal Circuit have required that the prior art not only include all of the claimed elements, but also some teaching, suggestion, or motivation to combine the known elements in the same manner set forth in the claim at issue. See, e.g., *ASC Hospital Systems Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (holding that obviousness

cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination.); *In re Mills*, 16 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 1990) (holding that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination). In *KSR*, the court noted that the demonstration of a teaching, suggestion, or motivation to combine provides a “helpful insight” in determining whether claimed subject matter is obvious. *KSR*, *slip op.* at 14. However, the court rejected a *rigid* application of the “TSM” test. *Id.* at 11. In this regard, the court stated:

The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and explicit content of issued patents. The diversity of inventive pursuit and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. *Id.* at 15.

In other words, the *KSR* court rejected a rigid application of the TSM test which requires that a teaching, suggestion or motivation to combine elements in a particular manner must be explicitly found in the cited prior art. Instead, the *KSR* court favored a

more expansive view of the sources of evidence that may be considered in determining an apparent reason to combine known elements by stating:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art all in order to determine whether there was an apparent reason to combine in the known elements in the fashion claimed in the patent at issue. *Id.* at 14.

The *KSR* court also noted that there is not necessarily an inconsistency between the idea underlying the TSM test and the *Graham* analysis, and it further stated that the broader application of the TSM test found in certain Federal Circuit decisions appears to be consistent with *Graham*. *Id.* at 17-18 (citing *DyStar Textilfarben GmbH and Co. v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (2006) (“Our suggestion test is in actuality quite flexible and not only permits but *requires* consideration of common knowledge and common sense”); *Alza Corp. v. Mylan Labs, Inc.*, 464 F.3d 1286, 1291 (2006) (“There is flexibility in our obviousness jurisprudence because a motivation may be found *implicitly* in the prior art. We do not have a rigid test that requires a teaching to combine ... ”)).

Furthermore, the *KSR* court did not diminish the requirement for objective evidence of obviousness. *Id.* at 14 (“To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”); see also, *In re Lee*, 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002) (holding that the factual inquiry whether to combine references must be thorough and searching, and that it must be based on *objective evidence of record*).

When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the

Examiner must not, "fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); see M.P.E.P. § 2143.01(VI). If the proposed modification or combination would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); see M.P.E.P. § 2143.01(V).

It appears that the Examiner's proposed combination of Gilliland and Yonemura is based solely on hindsight derived from applicants' specification. For at least the above reasons, Applicants request reconsideration and withdrawal of the rejection of Claim 3 under 35 U.S.C. § 103(a).

Examiner rejected claim 5 under 35 U.S.C. 103(a) as being unpatentable over Gilliland in view of Irie et al. (US 6,354,747 B2). Applicants respectfully traverses this rejection.

It appears that the Examiner's proposed combination of Gilliland and Irie is based solely on hindsight derived from applicants' specification. For at least the above reasons, Applicants request reconsideration and withdrawal of the rejection of Claim 3 under 35 U.S.C. § 103(a).

### Conclusion

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby requested.

Respectfully submitted,

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/John Pessetto/

John R. Pessetto, Reg. No. 48,369

KLAAS, LAW, O'MEARA & MALKIN, P.C.

P.O. Box 1920

Denver, Colorado 80201-1920

Tel. (303) 298-9888

Fax (303) 297-2266